

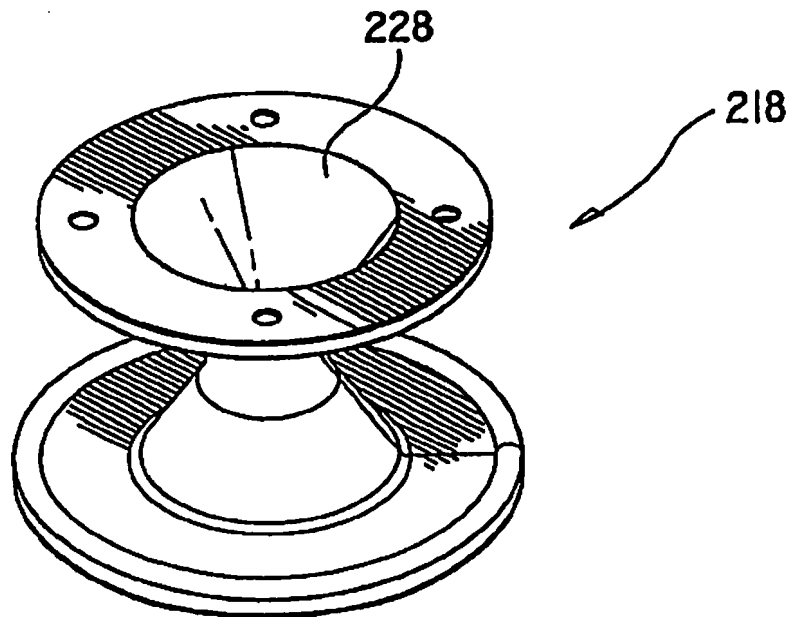
### **REMARKS**

The above-identified application has been considered in view of the Office Action that was mailed on August 5, 2009. Claims 5-9, 11, 13, 17, 20, and 32-36 are currently pending. By the present Amendment, Applicants have amended the written description, as well as independent claim 5, canceled claims 21-31, and added new claims 32-36 for consideration. Applicants respectfully submit that the amendments to written description and the claims effected herein, and the addition of new claims 32-36, do not introduce any new matter, and are fully supported by the specification as originally filed. In view of the following remarks and arguments, Applicants respectfully submit that claims 5-9, 11, 13, 17, 20, and 32-36 are allowable over the references of record, and accordingly, respectfully request allowance of these claims.

In the Office Action, the specification was objected to for failing to provide proper antecedent basis for a “sealing member” that is “non-inflatable,” as recited in claim 20.

Applicants respectfully submit that written description fails to provide any indication that the “sealing member” recited in claim 20 is inflatable in any manner. The word “inflatable” is never even utilized in the specification, thus implying that the “sealing member” is a “non-inflatable” structure.

Furthermore, Applicants draw attention to FIG. 12 below which illustrates the claimed “sealing member.” As can be seen in FIG. 12, the “sealing member” fails to include any enclosed, inflatable cavity, thus indicating that the claimed “sealing member” is “non-inflatable.”



**FIG. 12**

Accordingly, Applicants respectfully submit that the recitation of a “sealing member” that is “non-inflatable” finds adequate support in the specification, and as such, respectfully request withdrawal of the objection to the specification.

The drawings were also objected to, under 37 C.F.R. 1.83(a) for allegedly failing to illustrate every feature of the invention specified in the claims. Specifically, it was argued that “the ‘hourglass’ shaped seal member embodiment having [a] fabric and ring assembly must be shown.” (Office Action, page 3).

By the present amendment, the “ring assembly” formerly recited in the claims has been deleted in the interests of furthering prosecution. Accordingly, Applicants respectfully submit that the objection to the drawings has been rendered moot, and respectfully request withdrawal thereof.

Claims 5, 21, and 23-30 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for allegedly containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention.

With regard to claims 5 and 21, it was argued that “the disclosure does not have support for the sealing member positioned between the first ring and the second ring associating with the ‘hourglass’ shaped seal member.” (Office Action, page 4). Continuing, the Examiner argued that “[p]aragraph 0037 in the specification discloses ring embers (120, 122) are snap fitted together on either side of seal member (118), referring to Figure 2” and that “[a]ccordingly, the embodiment Figures 11-13 illustrating the ‘hourglass’ shape sealing member and these figures do not shown the rings on either side or ‘sandwiching’ the sealing member (218).” (Office Action, page 4). With particular respect to claim 5, it was also argued that “there is insufficient antecedent basis” for “the limitation ‘the instrument’ in line 10.” (Office Action, page 5).

Regarding claims 23-27, it was argued that the “specification does not have support for the attachment structures associating with ‘hourglass’ shaped seal member” since “paragraph 0037 in the specification discloses the attachment structures (120a, 120b, 122a, 122b) are snap fitting the ringer members (120, 122) together surrounding seal member (118), referring to Figure 2,” and that “[a]ccordingly, the embodiment [of] Figures 11-13 illustrating the ‘hourglass’ shape sealing member and these figures do not shown the attachment structures.” (Office Action, page 5).

With respect to claims 28-30, it was argued that the “specification does not have support for the dampening element associating with [the] ‘hourglass’ shaped seal member,” and that accordingly, “the dampening element is directed to the seal member (118) embodiment of Figure 2 and not with the seal member (218) embodiment of Figures 11-13.” (Office Action, page 5) (emphasis in original).

As mentioned above, the pending claims have been amended to remove the recitation of a “ring assembly.” Additionally, the pending claims have been amended to remove the recitation of a “dampening element.” Moreover, Applicants have amended claim 5 to recite “the surgical instrument” in line 10, antecedent basis for which is provided in line 5. (Emphasis added).

In view of these amendments, Applicants respectfully submit that the rejection of claims 5, 21, and 23-30 under 35 U.S.C. §112, first paragraph, has been overcome, and respectfully request withdrawal thereof.

Claims 5-9, 20-22, and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,391,154 to Young (hereinafter “Young”) in view of Stablein (DE 37 37 121 A1) (hereinafter “Stablein”). With respect to claims 21, 22, and 31, as mentioned above, these claims have been canceled herein. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 21, 22, and 31 under 35 U.S.C. §103(a) over Young in view of Stablein. Regarding claims 5-9 and 20, Applicants respectfully submit that the combination of Young and Stablein fails to render the subject matter of these claims obvious.

As a condition for patentability, 35 U.S.C. §103(a) indicates that “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art,” then the subject matter is not patentable. (Emphasis added).

As amended, independent claim 5 recites “[a] cannula assembly for use in a surgical procedure” including, *inter alia*, “a housing,” “a sealing member having proximal and distal faces disposed within the housing,” and “a seal clamp configured and dimensioned to secure an outer periphery of the sealing member within the housing.”

Young relates to “valve systems of the type adapted to allow the introduction of a surgical instrument into a patient's body,” and in particular, to “a cannula assembly and the like wherein a cannula extends from a valve assembly and is intended for insertion into a patient's body and an instrument is inserted into the patient's body through the cannula.” (Col. 1, lines 6-12). In one embodiment of the disclosure, Young describes a cannula assembly 10 with a valve assembly 12 including a valve housing 14 formed of half sections 16, 18, and a diaphragm 30. (See col. 4, lines 21-46; FIGS. 1-3). The diaphragm 30 is generally elongated in shape, and extends longitudinally through the valve housing 14. (See col. 4, lines 46-48; FIGS. 2, 3).

In the Office Action, Young's diaphragm 30 was characterized as the claimed “sealing member.” It was acknowledged, however, that the diaphragm 30 fails to include “a fabric material,” as recited in amended independent claim 5, but Stablein was relied upon for disclosure of this concept.

According to Young, “[t]he proximal end of the diaphragm 30 includes a circular flange 32 which fits tightly by a snap fit within a correspondingly dimensioned annular recess 34 formed on the proximal side of partition 26” and “[t]he distal end of diaphragm 30 also includes a circular flange 36 which fits tightly about the periphery of the proximal end portion 38 of neck 20, which extends within the interior of the valve housing 14.” (Col. 4, lines 48-56; FIGS. 2, 3).

The configuration of the diaphragm 30 thus facilitates direct attachment to the half sections 16, 18 of the housing 14.

In contrast, amended independent claim 5 recites additional structure which secures the “sealing member” to the “housing.” Specifically, amended independent claim 5 recites “a seal clamp configured and dimensioned to secure an outer periphery of the sealing member within the housing.”

Even if it is assumed, *arguendo*, that the characterization of Stablein proffered in the Office Action is accurate, and that Stablein is properly combinable with Young, incorporating the fabric purportedly disclosed in Stablein would fail to cure this deficiency in Young.

Accordingly, for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Young and Stablein fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that the combination of Young and Stablein fails to render the subject matter of amended independent claim 5 obvious. As such, Applicants respectfully submit that amended independent claim 5 is allowable over Young in view of Stablein under 35 U.S.C. §103(a). Since claims 6-9 and 20 depend either directly or indirectly from amended independent claim 5, and include each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Young in view of Stablein under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claims 6-9 and 20 are also allowable over Young in view of Stablein under 35 U.S.C. §103(a).

Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Young in view of Stablein and U.S. Patent No. 5,350,364 to Stephens, *et. al.* (hereinafter “Stephens”). Applicants respectfully submit, however, that the combination of Young, Stablein, and Stephens fails to render the subject matter of claim 13 obvious.

In the Office Action, it was acknowledged that the combination of Young and Stablein fails to disclose “a zero seal,” as recited in claim 13, but Stephens was relied upon for disclosure of this concept. (*See* Office Action, page 8).

Even if it is assumed, *arguendo*, that the characterization of Stephens proffered in the Office Action is accurate, and that Stephens is properly combinable with Young and Stablein, incorporating the “zero seal” purportedly disclosed in Stephens would fail to cure the aforescribed deficiencies in the combination of Young and Stablein.

Accordingly, for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Young, Stablein, and Stephens fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that the combination of Young, Stablein, and Stephens fails to render the subject matter of amended independent claim 5 obvious. As such, Applicants respectfully submit that amended independent claim 5 is allowable over Young in view of Stablein and Stephens under 35 U.S.C. §103(a). Since claim 13 depends directly from amended independent claim 5, and includes each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Young in view of Stablein and Stephens under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claim 13 is also allowable over Young in view of Stablein and Stephens under 35 U.S.C. §103(a).

Claims 11 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Young in view of Stablein and U.S. Patent No. 5,463,010 to Hu, *et al.* (hereinafter “Hu”). Applicants respectfully submit, however, that the combination of Young, Stablein, and Hu fails to render the subject matter of claims 11 and 17 obvious.

In the Office Action, it was acknowledged that the combination of Young and Stablein fails to disclose a “sealing member” including the features of the “coating” recited in claims 11 and 17, but Hu was relied upon for disclosure of this concept. (*See* Office Action, page 8).

Even if it is assumed, *arguendo*, that the characterization of Hu proffered in the Office Action is accurate, and that Hu is properly combinable with Young and Stablein, incorporating the “coating” purportedly disclosed in Hu would fail to cure the aforescribed deficiencies in the combination of Young and Stablein.

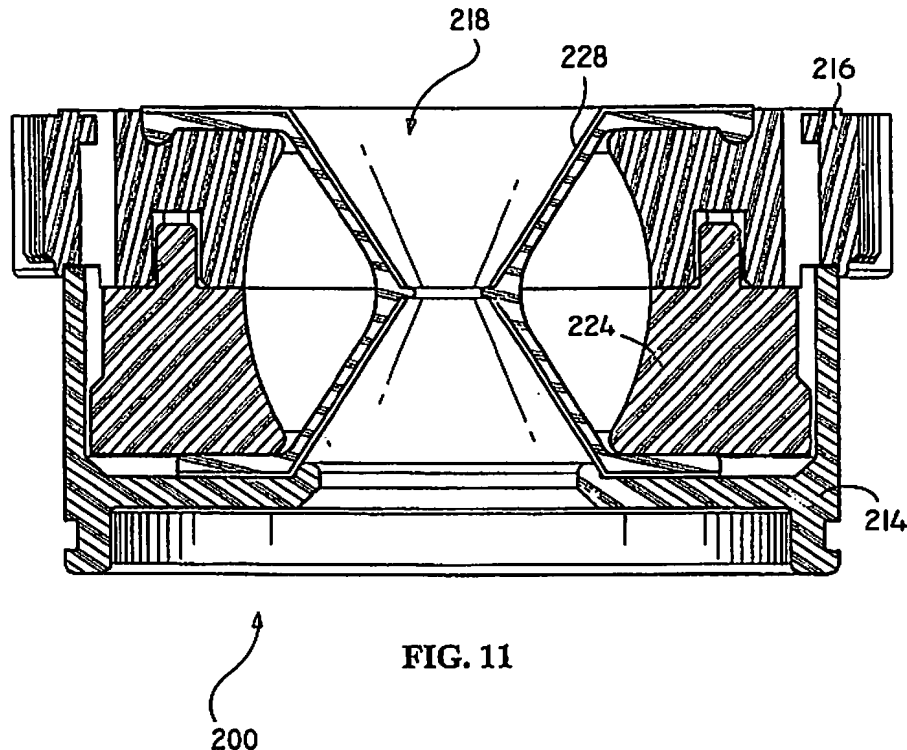
Accordingly, for at least this reason, *inter alia*, Applicants respectfully submit that the combination of Young, Stablein, and Hu fails to suggest the subject matter of amended independent claim 5 as a whole, and therefore, that the combination of Young, Stablein, and Hu fails to render the subject matter of amended independent claim 5 obvious. As such, Applicants respectfully submit that amended independent claim 5 is allowable over Young in view of Stablein and Hu under 35 U.S.C. §103(a). Since claims 11 and 17 depend directly and indirectly from amended independent claim 5, respectively, and include each element recited therein, for at least the reasons that amended independent claim 5 is allowable over Young in view of Stablein and Hu under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claims 11 and 17 are also allowable over Young in view of Stablein and Hu under 35 U.S.C. §103(a).



As mentioned above, Applicants have added new claims 32-34 for consideration. With respect to new claim 32, since this claim depends directly from amended independent claim 5, which is allowable in accordance with the foregoing discussion, for at least the reasons that amended independent claim 5 is allowable, *inter alia*, Applicants respectfully submit new claim 32 is also allowable.

Regarding new claims 33-36, Applicants respectfully submit that these claims recite a unique combination of features that is neither taught, nor suggested, by the references of record. For example, the references of record, when considered either alone or in any proper combination, do not disclose, or even suggest, “[a] cannula assembly” that includes, *inter alia*, “a housing,” “a cannula member . . . defining a longitudinal opening therethrough for passage of a surgical instrument,” and “a sealing member . . . disposed within the housing” wherein the “sealing member” has a “general hourglass shaped segment and an annular segment projecting radially inwardly from the hourglass segment, the annular segment defining an open aperture in an initial condition thereof for the receipt of the surgical instrument and arranged so that insertion of the instrument causes the aperture to expand to an expanded condition thereof whereby at least the annular segment resiliently contacts the outer surface of the instrument to form a substantial seal therewith.”

This feature is disclosed, e.g., in connection with the embodiment of FIG. 11 reproduced hereinbelow. The annular segment is disposed along the midline of the seal and depends inwardly from the hourglass segment to engage the surgical instrument.



For at least this reason, *inter alia*, Applicants respectfully submit that the subject matter of new independent claim 33 is allowable over the references of record. Since new claims 34-36 ultimately depend from new independent claim 33, and includes each element recited therein, for at least the reasons that new independent claim 33 is allowable over the references of record, *inter alia*, Applicants respectfully submit that new claim 34 is also allowable over the references of record.

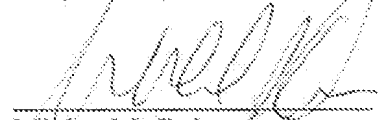
In view of the foregoing remarks and arguments, Applicants respectfully submit that claims 5-9, 11, 13, 17, 20, and 32-36 are in condition for allowance, and accordingly, respectfully request allowance of these claims.

Should the Examiner feel that an interview may facilitate the resolution of any outstanding matters, the Examiner is sincerely invited to contact Applicants' undersigned

attorney at the number indicated below.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



Michael J. Debono  
Reg. No. 62,877  
Attorney for Applicants

***Carter, DeLuca, Farrell & Schmidt, LLP***  
445 Broad Hollow Road, Suite 420  
Melville, New York 11747  
Tel.: (631) 501-5700  
Fax: (631) 501-3526

**Send correspondence to:**  
Chief Patent Counsel  
Covidien  
60 Middletown Avenue  
North Haven, Connecticut 06473